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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,790	10/19/2001	Paul James Hough	MICR0252	6061

27792 7590 09/07/2005

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EXAMINER

BRUCKART, BENJAMIN R

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/016,790

Applicant(s)

HOUGH ET AL.

Examiner

Benjamin R Bruckart

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

*Detailed Action*

Claims 1-27 are pending in this Office Action.

*Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claims 1, 12, 21, 26, 27, the applicant claims a method, system, and apparatus for including a software resource as a participant within an online chat session through a messaging service but does not define within the body of the claim the hardware in which the invention runs. The claims read as software without hardware embodiment over a network.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 3-4, 6-13, 15-17, 20-24, 26-27 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,346,952 by Shtivelman.**

Regarding claim 1, a method for including a software resource as a participant within an online chat session conducted through a messaging service (Shtivelman: col. 4, lines 37-47), comprising the steps of:

Art Unit: 2155

(a) registering the software resource to indicate that it is available to participate in an online chat session, when said software resource is executed (Shtivelman: col. 11, lines 17-21);

(b) enabling a user to include the software resource within a list of participants in the online chat session (Shtivelman: col. 7, lines 9-13, lines 46-60);

(c) enabling a user to enter a plain language message within an online chat session user interface (Shtivelman: col. 12, lines 28, lines 52-57);

(d) transmitting the message to the software resource (Shtivelman: col. 12, lines 52-57; parse incoming queries);

(e) parsing the plain language message received by the software resource (Shtivelman: col. 12, lines 52-57; parse incoming queries);

(f) determining a plain language response to the message (Shtivelman: col. 13, lines 1-18); and

(g) transmitting the plain language response from the software resource back to the user (Shtivelman: col. 13, lines 45-61).

Regarding claim 3, the method of claim 1, further comprising the step of enabling the user to selectively add another person as a participant in the online chat session, said other person also receiving the plain language response from the software resource (Shtivelman: col. 7, lines 46-60).

Regarding claim 4, the method of claim 1, wherein, if the software resource is unable to determine a plain language response to the plain language message, the response is one of a nil response and an indication that a response cannot be provided (Shtivelman: col. 14, lines 31-33; ignored... nil response).

Regarding claim 6, the method of claim 1, wherein the plain language message comprises a query, and the plain language response comprises data responsive to the query (Shtivelman: col. 12, lines 49- col. 13, line 6).

Regarding claim 7, the method of claim 1, wherein, for the user, the online chat session is implemented by a messaging service program (Shtivelman: col. 6, lines 1-14; instant messaging).

Regarding claim 8, the method of claim 1, wherein the step of registering comprises the step of registering with a messaging service server through which the messaging service is implemented for all participants in the online chat session, including the software resource (Shtivelman: col. 7, lines 12-15; joining in a chat session; col. 11, lines 20-21; log-on).

Regarding claim 9, the method of claim 1, wherein the step of determining the plain language response includes the step of employing the software resource to search through data accessible by the software resource to find data provided in the plain language response (Shtivelman: col. 12, lines 52- col. 13, lines 27; matching query with response).

Regarding claim 10, a machine readable media having processor-executable machine instructions for performing steps (b)-(d) as recited in claim 1 (Shtivelman: col. 7, lines 9-26).

Regarding claim 11, a machine readable media having processor-executable machine instructions for performing steps (a) and (e)-(g) as recited in claim 1 (Shtivelman: col. 11, lines 20-21; col. 12, lines 49- col. 13, line 12).

Regarding claim 12, a method for accessing information available through a software resource during a messaging service session (Shtivelman: col. 4, lines 37-47), comprising the steps of:

(a) indicating each participant in the messaging service session, a software resource being included as a participant (Shtivelman: col. 7, lines 9-13, lines 46-60);

Art Unit: 2155

(b) enabling a user to enter a plain language query in the messaging service session (Shtivelman: col. 12, lines 28, lines 52-57);

(c) transmitting the plain language query to the software resource (Shtivelman: col. 12, lines 52-57; parse incoming queries);

(d) parsing the plain language query at the software resource (Shtivelman: col. 12, lines 52-57; parse incoming queries);

(e) automatically determining information responsive to the software query, using the software resource (Shtivelman: col. 13, lines 1-18); and

(f) transmitting the information responsive to the software query back to the user (Shtivelman: col. 13, lines 45-61).

Regarding claim 13, the method of claim 12, wherein the software resource and all other participants in the messaging service session are coupled in communication over a network (Shtivelman: col. 4, lines 37-54; col. 5, lines 9-20).

Regarding claim 15, the method of claim 12, further comprising the step of enabling the user to selectively direct the plain language query to the software resource (Shtivelman: col. 12, lines 35-54; Figure 8).

Regarding claim 16, the method of claim 12, wherein the software resource comprises a data manager program that accesses a store of data to find the information responsive to the plain language query transmitted from the user (Shtivelman: col. 13, lines 1-18).

Regarding claim 17, the method of claim 12, further comprising the step of transmitting an indication from the software resource to the user that information responsive to the plain language query could not be provided (Shtivelman: col. 13, lines 45-61).

Regarding claim 20, the method of claim 12, wherein a plurality of software resources are included in a list of prospective participants in the messaging service session (Shtivelman: Figure 8, tag 169).

Regarding claim 21, a system for enabling a software resource to respond as a conventional participant in a messaging service session implemented over a network (Shtivelman: col. 4, lines 37-47), comprising:

(a) a messaging service server coupled to the network and programmed for implementing registration of prospective instant message participants available to be added to a messaging service session as participants (Shtivelman: col. 5, lines 9-28; col. 7, lines 9-20);

(b) a user computing device coupled to the network and including a processor (Shtivelman: col. 5, lines 9-25) programmed to:

(i) execute a messaging service session in which a user is a participant (Shtivelman: col. 7, lines 9-15; Figure 8);

(ii) add a software resource as a participant in the messaging service session (Shtivelman: col. 7, lines 9-13, lines 46-60); and

(iii) enable a user to enter a plain language query for information to be obtained from the software resource within the messaging service session (Shtivelman: col. 12, lines 28, lines 52-57); and

(c) a software resource computing device coupled to the network and programmed (Shtivelman: col. 7, lines 20-35) to:

(i) execute the software resource (Shtivelman: col. 7, lines 9-13);

(ii) register the software resource with the messaging service server when the software resource is available to participate in a messaging service session (Shtivelman: col. 7, lines 13-19; joining in running chat session; col. 11, lines 20-21; log-on);

(iii) parse a plain language query received from the user during the messaging service session (Shtivelman: col. 12, lines 52-57; parse incoming queries);

(iv) access data with the software resource to find information responsive to the plain language query (Shtivelman: col. 13, lines 1-18); and

(iv) transmit said information to the user computing device over the network (Shtivelman: col. 13, lines 45-61).

Regarding claim 22, the system of claim 21, wherein the software resource computing device includes a data store from which the information is derived to respond to the plain language query received during the messaging service session (Shtivelman: col. 13, lines 1-13; KB= knowledge base).

Regarding claim 23, the system of claim 21, wherein the user computing device includes a user interface that enables a user to enter the plain language query into the messaging service session (Shtivelman: col. 12, lines 28, lines 52-57).

Regarding claim 24, the system of claim 21, wherein the user computing device includes a display on which the messaging service session is viewed, an image viewable during said messaging service session including an indication of whether the software resource is available to participate in the messaging service session (Shtivelman: figure 8).

Regarding claim 26, apparatus that enables a user to interact with a software resource during a messaging service session (Shtivelman: col. 4, lines 37-47), comprising:

- (a) a network interface that connects to a network over which the messaging service session is communicated (Shtivelman: col. 4, lines 37-54; col. 7, lines 9-13; computer equipment);
- (b) a display (Shtivelman: col. 7, lines 9-13; computer equipment; Figure 8);
- (c) a user input device (Shtivelman: col. 7, lines 9-13; computer equipment; to input text for query);
- (d) a memory in which a plurality of machine instructions are stored (Shtivelman: col. 7, lines 9-13; computer equipment); and
- (e) a processor coupled to the network interface, the display, the user input device, and the memory, said processor executing the machine instructions, causing the processor



Art Unit: 2155

to carry out a plurality of functions (Shtivelman: col. 7, lines 9-13; computer equipment), including:

- (i) registering a user with a messaging service as being available to participate in a messaging service session (Shtivelman: col. 7, lines 9-19; joining and participating in a session);
- (ii) enabling a user to add one or more participants to a messaging service session, at least one participant that is added comprising a software resource that is registered as being available to participate in the messaging service session as a participant (Shtivelman: col. 7, lines 9-13, lines 46-60);
- (iii) enabling a user to enter a plain language query with the user input device (Shtivelman: col. 12, lines 28, lines 52-57);
- (iv) transmitting the plain language query over the network to each participant in the messaging service session (Shtivelman: col. 7, lines 46-60); and
- (v) receiving a response over the network from a software resource responding to the plain language query (Shtivelman: col. 13, lines 45-61).

Regarding claim 27, apparatus that enables a software resource to interact as a participant during a messaging service session (Shtivelman: col. 4, lines 37-47), comprising:

- (a) a network interface that connects to a network over which the messaging service session is communicated (Shtivelman: col. 4, lines 37-54; col. 7, lines 9-13; computer equipment);
- (b) a memory in which a plurality of machine instructions are stored (Shtivelman: col. 13, lines 1-13; KB); and
- (c) a processor coupled to the network interface, and the memory, said processor executing the machine instructions, causing the processor to carry out a plurality of functions (Shtivelman: col. 7, lines 9-13; computer equipment), including:
  - (i) registering the software resource with a messaging service as being available to participate in a messaging service session (Shtivelman: col. 7, lines 9-19; col. 11, lines 20-21);

Art Unit: 2155

(ii) parsing a plain language query received from a user during a messaging service session in which the software resource has been added as a participant (Shtivelman: col. 12, lines 49-67; parsing incoming query);

(iii) finding data responsive to the plain language query (Shtivelman: col. 13, lines 1-13); and

(iv) transmitting the data over the network to a user who entered the plain language query (Shtivelman: col. 13, lines 45-61).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2, 5, 14, 18, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent No. 6,346,952 by Shtivelman in view of U.S. Patent No. 6,564,261 by Gudjonsson et al ("Gudj").**

Regarding claim 2,

The Shtivelman reference teaches the method of claim 1, further comprising the step of enabling the user to selectively direct the message to the software resource (Shtivelman: col. 12, lines 35-54; Figure 8).

The Shtivelman reference does not explicitly state directing the message but shows it once a conversation is started (Fig. 8).

The Gudj reference teaches selectively directing the message to another user (Gudj: col. 9, lines 14-17; the invitation).

The Gudj reference further teaches the invitation requests are requests join in a communication session (Gudj: col. 9, lines 8-10).

Art Unit: 2155

Therefore it would have been obvious at the time of the invention to one of ordinary skill in the art to create the method of software resource in a chat session as taught by Shtivelman while employing directing the message as taught by Gudj in order to create a communication session between two entities (Gudj: col. 9, lines 8-10).

Claim 5 is rejected under the same rationale given above. In the rejections set forth, the examiner will address the additional limitations and point to the relevant teachings of Shtivelman and Gudjonsson et al.

Regarding claim 5, the method of claim 1, further comprising the step of providing a graphic indication that the software resource is online and available to participate in the online chat session as a participant (Shtivelman: Figure 8; agent assigned to session; col. 11, lines 20-26; Gudj: col. 11, lines 50-59).

Regarding claim 14,

The Shtivelman reference teaches the method of claim 12.

The Shtivelman reference does not explicitly state selectively adding the software resource.

The Gudj reference teaches enabling the user to selectively add a user to the messaging service session from a list of prospective participants (Gudj: col. 12, lines 55-65).

The Gudj reference further teaches the invitation requests are requests join in a communication session (Gudj: col. 9, lines 8-10).

Therefore it would have been obvious at the time of the invention to one of ordinary skill in the art to create the method of software resource in a chat session as taught by Shtivelman while employing directing the message as taught by Gudj in order to create a communication session between two entities (Gudj: col. 9, lines 8-10).

Art Unit: 2155

Claim 18 is rejected under the same rationale given above. In the rejections set forth, the examiner will address the additional limitations and point to the relevant teachings of Shtivelman and Gudjonsson et al.

Regarding claim 18, the method of claim 12, further comprising the step of providing an indication to a user when the software resource is unavailable to participate in a messaging service session (Gudj: col. 11, lines 50-59).

Regarding claim 25,

The Shtivelman reference teaches the system of claim 21.

The Shtivelman reference does not explicitly state selectively add a software resource.

The Gudj reference teaches a user computer device is programmed to enable a user to selectively add another user as a participant in the messaging service session (Gudj: col. 11, lines 50-59).

The Gudj reference further teaches the invitation requests are requests join in a communication session (Gudj: col. 9, lines 8-10).

Therefore it would have been obvious at the time of the invention to one of ordinary skill in the art to create the method of software resource in a chat session as taught by Shtivelman while employing directing the message as taught by Gudj in order to create a communication session between two entities (Gudj: col. 9, lines 8-10).

**Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent No. 6,346,952 by Shtivelman in view of U.S. Patent No. 6,373,853 by Yoshida.**

Regarding claim 19,

The Shtivelman reference teaches the method of claim 12.

The Shtivelman reference does not explicitly state retrieving a network address from a knowledge base.

Art Unit: 2155

The Yoshida reference does teach information provided by the software resource includes a network address at which data responsive to the query are located (Yoshida: col. 6, lines 47-61).

The Yoshida reference further teaches the mapping table helps resolve dynamic address information (Yoshida: col. 1, lines 14-43)

Therefore it would have been obvious at the time of the invention to one of ordinary skill in the art to create the method of software resource in a chat session as taught by Shtivelman while employing network address data as taught by Yoshida in order to map dynamically address resources (Yoshida: col. 1, lines 14-43).

### *Conclusion*

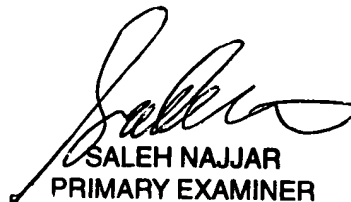
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin R Bruckart whose telephone number 571-272-3982. The examiner can normally be reached on 8:00-5:30 PM with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3982.

Benjamin R Bruckart  
Examiner  
Art Unit 2155  
brb  
1-25-05

BRB

  
SALEH NAJJAR  
PRIMARY EXAMINER